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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* STEFANO FACCINN, TUIJA HURTTA, BALAZS BERTENYI,  
NEDKO IVANOV, HARRI, HONKO, JUHA-PEKKA KOSKINEN,  
JUHA VALLINEN, and MERJA HOPEAHARJU

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Appeal 2009-012657  
Application 09/758,267  
Technology Center 2400

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Before JOSEPH F. RUGGIERO, ALLEN R. MacDONALD, and  
CARLA M. KRIVAK, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

## STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Final Rejection of claims 38 and 39. Claims 7, 20, 21, 23, and 33-37 have been canceled, and claims 1-6, 8-19, 22, and 24-32 have been allowed. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Appeal Brief (filed Oct. 8, 2008), the Examiner's Answer (mailed Dec. 4, 2008), and the Reply Brief (filed Feb. 3, 2009). Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived (*see* 37 C.F.R. § 41.37(c)(1)(vii)).

### *Appellants' Invention*

Appellants' invention relates to the coordination of charging (billing) information between application and transport layers of a communication network. *See generally* Spec. 1:13-15 and 5:2-16.

Claims 38 and 39 are illustrative of the invention and read as follows.

38. A network element for use in coordinating charging information, the network element being configured to:

create call records and a charging identification for use in one of an application layer network or a transport layer network for a communications network having a billing system wherein a first connection is established in the application layer network by a user equipment using a call control

protocol and a second connection is established in the transport layer network by said user equipment;  
include the charging identification in the call records thereof;  
send said call records to said billing system; and  
send said charging identification from said network element so as to be used by a further network element in the other one of the application layer network or the transport layer network, to enable charging information for the elements to be coordinated.

39. A network element for use in coordinating charging information, the network element being configured for use in one of an application layer network or a transport layer network for the communications network having a billing system wherein a first connection is established in the application layer network by a user equipment using a call control protocol and a second connection is established in the transport layer network by said user equipment, said network element being configured to:

create call records for said second connection in said transport layer network;  
send said call record to said billing system; and  
receive said charging identification from a further network element operable in the other one of the application layer network or the transport layer network, to enable charging information for the elements to be coordinated.

### *The Examiner's Rejections*

The Examiner relies on the following prior art references to show unpatentability:

Kari	WO 97/26739	July 24, 1997
Deakin	US 6,463,275 B1	Oct. 8, 2002 (Filed Jan. 31, 2000)
Cobo	US 6,496,690 B1	Dec. 17, 2002 (Filed May 7, 1999)

Claims 38 and 39 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Kari.

Claims 38 and 38 stand further rejected under 35 U.S.C. § 103(a) as being unpatentable over Deakin in view of Cobo.

## ANALYSIS

### 35 U.S.C. § 102(b) REJECTION

We find the Examiner erred in determining that all of the limitations of appealed claims 38 and 39 are present in the disclosure of Kari, and accordingly, the anticipation rejection is not sustained. We agree with Appellants (App. Br. 7; Reply Br. 4-5) that the Examiner has not satisfactorily explained what elements in Kari correspond to the claimed application layer network and transport layer network.

The Examiner has identified Kari's near end MS, MSC GGSN, SGSN, HLR Internet, and far end MS elements as corresponding to the claimed application layer network and the near end MS, BSC, MSC, SGSN, GGSN, Internet, and far end MS components as corresponding to the claimed transport layer network (Ans. 11). As argued by Appellants (Reply Br. 4), however, the Examiner has not indicated, for example, why Kari's BSC element is included in the application layer grouping, but not the transport layer grouping. Further, we agree with Appellants that while the Examiner identifies an "HLR Internet" element in Kari, we find no mention of an HLR in Kari.

We also agree with Appellants that the Examiner erred in determining that Kari's IMSI identifier corresponds to the claimed "charging identification" feature. As argued by Appellants (App. Br. 8; Reply Br. 4), Kari's IMSI identifier is an equipment identifier which is used to authorize

subscriber access to a network, but is not created by a network element, or received across application layer and transport layer networks as claimed.

### 35 U.S.C. § 103(a) REJECTION

#### *Claim 38*

The Examiner's obviousness rejection of claim 38 based on the combination of Deakin and Cobo is also not sustained. We agree with Appellants (App. Br. 10; Reply Br. 5-6) that the Examiner erred (Ans. 7 and 23) in determining that the identified SGSN or GGSN network elements in Deakin create a charging identification as claimed. While Deakin's network elements illustrated in Figure 2 are disclosed as generating call detail records (CDRs) which include a BCI billing identifier, the BCI identifier is not created at the network element. Instead, the BCI identifier is received from Deakin's home location register (HLR) where it is stored as part of a user's subscription information (col. 2, ll. 38-39 and col. 3, ll. 24-37). We also find nothing in Cobo which overcomes the above noted deficiency of Deakin.

#### *Claim 39*

We sustain the Examiner's obviousness rejection of claim 39 based on the combination of Deakin and Cobo. At the outset, we note that, unlike previously discussed claim 38, there is no requirement that the network element of claim 39 *create* a charging identification. Instead, there is only a requirement that the recited network element creates call records and receives charging identification from a further element.

With the above discussion in mind, we find that, while the Examiner relies (Ans. 27) on Cobo for teaching a network element receiving a

charging identification from a further network element, any such teaching is cumulative to what is disclosed by Deakin. As illustrated in Figure 2 of Deakin, and as acknowledged by Appellants in their arguments with respect to claim 38, the network elements NE1 and NE2 receive charging identification from the home location register (HLR). We find that Deakin's HLR element is a "further network element" as claimed. Moreover, this HLR element is included in the application layer network elements identified by the Examiner (Ans. 22) while the SGSN and GGSN elements which receive the charging identification are included the identified transport layer network elements.

We also find no error in the Examiner's identification (Ans. 22) of the elements of Deakin which correspond to the claimed application layer network and transport layer network. While we found Appellants' arguments challenging the Examiner's identification of supposed application layer and transport layer elements in the previously discussed Kari reference to be persuasive, we find that Appellants arguments (App. Br. 9) with respect to Deakin are merely conclusory in nature.

Lastly, we find that the Examiner has provided a valid articulated line of reasoning with a rational underpinning to support the obviousness of applying the call control protocol teachings of Cobo to the communication network system of Deakin (Ans. 25). Appellants' argument that, since both Deakin and Cobo disclose communication networks with their own prepaid billing features, Cobo could not be said to teach an improvement to Deakin is not persuasive. We agree with the Examiner that an ordinarily skilled artisan would have recognized and appreciated that Cobo's teaching of providing a near real time account balance with stopping of service when the

balance reaches zero would have served as an obvious enhancement to the network system of Deakin.

### CONCLUSION

Based on the analysis above, we conclude that, with respect to the Examiner's 35 U.S.C. § 102(b) rejection based on Kari, Appellants have shown the Examiner erred in rejecting claims 38 and 39. With respect to the 35 U.S.C. § 103(a) rejection based on the combination of Deakin and Cobo, we conclude that Appellants have shown the Examiner erred in rejecting claim 38, but have not shown the Examiner erred in rejecting claim 39.

### DECISION

The Examiner's decision rejecting claims 38 and 39 is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

### AFFIRMED-IN-PART

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